REMARKS/ARGUMENTS

Amendments have been made to the claims to further clarify their meaning and scope, both in view of Examiner's comments and indirectly as a result of Applicant's review. New claims 60 to 65 correspond in scope with existing independent claims, except for a change in emphasis for the purposes of contributory infringement. Examiner will note that the new claims incorporate all features of the independent claims upon which they are based.

It is submitted that none of the amendments enter new matter or raise new issues for consideration. Specific points will be discussed further under relevant headings below.

SPECIFICATION

Page 1 has been amended to replace the docket numbers with updated serial numbers (and patent numbers where relevant).

CLAIM REJECTIONS – 35 USC 101

Independent claims 1, 4, 5 and 33 have been amended. The intended meaning of the original phrase "providing a user with a form" was that the form was being provided to the purchaser, not that the purchaser was being provided in any way. Applicant submits that the new wording of the claims clarifies this intention without adding new matter or raising new issues for Examiner's consideration.

CLAIM REJECTIONS – 35 USC 112

The phrase "the parameter" has been replaced with "the at least one parameter" in claims 8, 10, 12 and 15.

The word "substantially" has been deleted from claim 23.

Claim 26 has been amended to clarify which purchaser is being referred to.

Amendments to claim 33 remove the antecedent basis referred to by Examiner.

CLAIM REJECTIONS – 35 USC 102

Applicant has reviewed Perazza in detail and submits that it does not anticipate the present claims as amended.

Perazza is concerned with providing an offline method by which a user or user can pay bills. A pen or pencil is used to obscure numbers or barcodes on a form to indicate dollar amounts (for example). Similarly, various options, such as payment dates, can be selected by obscuring barcodes (see Figs 2 and 3, for example). The completed form is forwarded to a clearing house, where it is placed on a scanner that extracts the data entered by the user. Funds transfer is then performed on the basis of the extracted information.

In contrast, the present application is concerned with allowing a user to perform an online billing transaction. In general terms, the present invention as claimed is distinct from Perazza simply on the basis that Perazza is an offline system. A user completes the form with a regular pen or pencil, and then forwards it to a clearing house for processing.

In contrast, the present invention is concerned with a user using a sensing device to facilitate an online bill paying transaction. Coded data is sensed with the sensing device, and the sensed data is sent to a computer system. The features of individual claims are discussed in more detail below.

Applicant submits that there are a number of other more specific features in the various claims that are not disclosed in Perazza. However, Examiner has rejected a vast majority of the claims whilst listing only a handful of features that are said to be disclosed in Perazza. In the absence of any specific guidance by Examiner, Applicant has been unable to determine what features of Perazza are believed to equate with the features defined in the present claims. It would therefore be appreciated if Examiner would explicitly point out the sections of Perazza that are believed to anticipate the features of all the claims, in the event that any of the claim rejections are to be maintained in view of this response. This will enable Applicant to provide a more focussed reply to any further Office Actions.

Applicant will now go through some of the claims feature by feature and point out those that are not disclosed by Perazza. Only the independent method claims, and some selected dependent claims, have been discussed, for the sake of brevity. However, the other independent claims incorporate corresponding combinations of features, and so the arguments below apply equally to them.

Claim language is in italics, and Applicant's comments follow as bullet points:

1. *A method of supporting a user in performing online bill payment,*

- Perazza in no way supports online bill payment. In Perazza, a user scribbles out codes with a pen or pencil to indicate numbers that are selected. The form is then mailed for processing. This is clearly not "performing online bill payment"

- Should Examiner wish to assert that there is an "online" element to the system disclosed in Perazza, it would be appreciated if Examiner would provide a basis for such a conclusion based on how one skilled in the art would read Perazza and the present claims.

the method including the steps of:

providing a printed form to the user, the printed form containing information relating to a bill paying transaction,

- Perazza discloses this feature.

and including coded data indicative of an identity of the form and of at least one reference point of the form, the information and the coded data of the form having been printed substantially simultaneously;

- Perazza does not disclose this feature. To understand this issue, it is critical to note the distinction between coded data and the mechanism used to encode it. In Perazza, the closest that any of the coded data comes to being indicative of a reference point of the form is the print indicators in the form of barcodes at the top and bottom left of the form. However, in that case it is not the *coded data* that is indicative of a reference point. Rather, the only indication of position provided by the barcodes is based on the actual printed position of the barcodes themselves. There is no

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disclosure of the coded data of the barcodes being in any way indicative of a reference point of the form. This is a subtle issue, but one which is critical to appreciating how the present invention differs from Perazza.

• Perazza is also silent on the issue of providing coded data that is indicative of an identity of the form. At best, the forms in Perazza are preprinted to indicative the user that they come from. However, there is nothing to indicate that any of the forms have an identity, much less that such an identity is encoded in coded data.

receiving, in a computer system, indicating data from a sensing device operated by the user,

• In Perazza, it is clear that <u>the</u> user does not <u>operate</u> the sensing device (which can be considered the optical scanner 78) as defined here. In the present claim, the user is defined initially as being the one performing an online payment. This feature then states that the sensing device is operated by <u>the</u> user. There is no utterly suggestion or expectation that the person completing the form in Perazza would use the optical scanner, since the scanner is operated as part of a remote clearing house.

the indicating data being indicative of an identity of the form and of a position of the sensing device relative to the form,

• Perazza fails to disclose these features. In Perazza, the indicating data is generated as a result of what is scanned from the form by the optical scanner 78. There is no disclosure or suggestion that the (indicating) data generated as a result of the scanning process in Perazza contains any information relating either to an identity of the form, or, more particularly, to a position of the sensing device relative to the form. Examiner will appreciate that the position of the sensing device relative to the form is an important aspect of the present invention. In contrast, the scanner in Perazza is configured to scan all the information on the form, and to perform a bill paying transaction based on the data extracted. There is nothing to suggest that the extracted data in Perazza has anything to do with a position of the optical scanner, nor would there be any purpose for such data in Perazza if it existed.

the indicating data having been generated by the sensing device using at least some of the coded data it sensed when placed in an operative position relative to the form;

• Whilst this is a question of semantics, the present claim requires that the sensing device be placed into an operative position relative to the form. In Perazza, the form is placed onto a conveyor belt and scanned automatically by the optical scanner 78. Applicant submits this is not the same as placing the scanner into an operative position relative to the form, since there is no disclosure of the scanner being "placed" in any way.

and
identifying, in the computer system and from the indicating data, at least one parameter relating to the bill paying transaction.

• In the absence of indicating data as defined earlier in the claim, it is submitted that Perazza cannot identify a parameter relating to a bill paying transaction based on such indicating data.

- For all these reasons, it is submitted that claim 1 is allowable over Perazza.

2.   *The method of claim 1 in which said at least one parameter relating to the bill paying transaction is associated with at least one zone of the form and in which the method includes identifying, in the computer system and from the zone indicated by the position of the sensing device as indicated by the indicating data, said at least one parameter.*

- As described above, the indicating data disclosed by Perazza in no way discloses a position of the sensing device in any meaningful way. The data that is sensed in Perazza is limited to currency information (the amount being paid), date information, account information and the like.

- Moreover, there is no disclosure in Perazza of a "zone" of the form, nor any suggestion that any zone information can be determined from the indicating data.

- For these reasons, it is submitted that claim 2 is allowable over Perazza.

3.   *The method of claim 2 wherein the indicating data includes movement data indicative of movement of the sensing device relative to the form,*

- The indicating data is Perazza is generated after the form is scanned using optical scanner 78. There is utterly no disclosure or suggestion that this data includes any form of movement data, let alone that such movement data is *indicative of movement of the sensing device relative to the form*. Again, it is critical to note the distinction between data *caused* by movement, and data that itself contains movement data. It is acknowledged that there is relative movement between the scanner and the form during scanning. However, there is nothing in the indicating data generated in Perazza to suggest that data indicative of that relative movement is captured and passed on the computer system.

the sensing device having generated the movement data using at least some of the coded data,

- Again, there is no disclosure of such a feature. The coded data is read only for the purpose of determining currency and date values, and not for generating *movement data*.

and wherein the at least one parameter is identified in the computer system by determining that the movement was at least partially within said at least one zone.

- As mentioned above, there are no *zones* disclosed in Perazza. There is also no disclosure of identifying a parameter in the computer system by determining that the movement was at least partially within such a zone.

4.   *A method of supporting a user in performing online bill paying,*

- The comments made in relation to this feature in claim 1 apply.

the method including the steps of:

providing a printed form to the user, the printed form containing information relating to a bill paying transaction and including coded data indicative of at least one parameter of the bill paying transaction, the information and coded data of the form having been printed substantially simultaneously;

- It is admitted that Perazza discloses these features.

receiving, in a computer system, indicating data from a sensing device operated by the user,
- As discussed in relation to claim 1, the sensing device in Perazza is an automated scanner, and in any event is not operated by <u>the</u> user.

the indicating data being indicative of said at least one parameter and of movement of the sensing device relative to the form, the sensing device having generated the indicating data by sensing at least some of the coded data when the sensing device was moved relative to the form;

- The indicating data in Perazza is not indicative of movement of the sensing device relative to the form, for the reasons discussed in relation to claim 3.

and

interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter.

- There is no disclosure in Perazza of interpreting movement of a sensing device relative to a form.

5.　A method of supporting a user in performing online bill paying using a printed form containing information relating to a bill paying transaction, the form including coded data indicative of an identity of the form,

- As described above, Perazza does not disclose coded data indicative of an identity of the form.

the method including the steps of:

receiving, in a computer system, indicating data from a sensing device, the indicating data being indicative of an identity of the user and of the identity of the form, the sensing device having determined the indicating data related to the identity of the user using identity data stored in the sensing device and having determined the indicating data relating to the identity of the form by sensing at least some of the coded data;

- Any identification of a user in Perazza is based on data printed on the form. There is utterly no disclosure of identity data being stored in the sensing device and being user to generate indicating data as defined in this claim.

and

identifying, in the computer system and from the indicating data, a bill paying transaction.

7. *The method of claim 6, which includes receiving, in the computer system, movement data from the sensing device indicative of movement of the sensing device relative to the form, the sensing device having generated the movement data.*

- Perazza does not disclose movement data as defined in this claim.

DOUBLE PATENTING

To overcome the objection, the Applicant encloses a Terminal Disclaimer.

CLAIM REJECTIONS – 35 USC 103

It is believed that the arguments above overcome all objections for the independent claims, and that the remaining dependent claims are therefore allowable. However, Applicant makes the following general comments about the citations combined with Perazza by Examiner.

The XEROX application is concerned with providing coded data that is sensed by an active sensing device operated by a user. Examiner contends that providing the sensing device of Perazza with such a nib would be obvious because "should marks be necessary on the bill, they can be made at the time of reading the bill with the sensing device". However, the sensing device in Perazza is the optical scanner 78 that is used offline to scan forms already completed by a user with an ordinary pen or pencil. There would be no reason to provide the optical scanner with a marking nib, because at this stage all marking of the forms is already completed. Moreover, the user has already used a pen or pencil with a marking nib, so what would be the point of adding a further such feature anywhere else in the system?

As for the data being substantially invisible, this would render the forms in Perazza nonsensical. Perazza relies on a user using a pen or pencil to obscure visible coded data. If the coded data was invisible, how is a user supposed to see it to scribble it out?
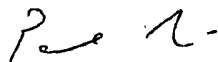
As for the Sekendur patent, Applicant again points out that the sensing device in Perazza is the optical scanner. All of the data mentioned by Examiner as being made available by the sensing device of Sekendur is not retrievable by adding these features to the optical scanner of Perazza. It is critical to understand that the sensing device of the present invention (and Sekendur, for that matter) is a pen-like device used by a user to write on a form. The data such as pen tilt, digital ink, wireless pen interface and so on are only relevant in a system where such a pen is used.

In contrast, Perazza is an online system in which a *completed* form is scanned offline for coded data. At this point, it is not feasible to determine most of the features of claims 50, 52-54, 56 and 59, since it is necessary that such information be determined in a pen (such as that described in the present preferred embodiment) as the form is being written on. The proposed modification to the optical scanner of Perazza therefore does not make sense. Even if one considered it obvious to make such a modification, it is clear that the hardware of Sekendur could not be applied to the optical scanner to obtain the operability defined in these claims. For these reasons, it is submitted that it would not have been obvious to modify Perazza with reference to Sekendur.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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